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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/806,421	03/23/2004	Hideaki Naruse	Q80646	2271

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EXAMINER

THOMPSON, CAMIE S

ART UNIT	PAPER NUMBER
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1774

DATE MAILED: 05/15/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

<b>Office Action Summary</b>	<b>Application No.</b>	<b>Applicant(s)</b>	
	10/806,421	NARUSE ET AL.	
	<b>Examiner</b>	<b>Art Unit</b>	
	Camie S. Thompson	1774	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

#### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

#### Status

- 1) ☐ Responsive to communication(s) filed on \_\_\_\_.
- 2a) ☐ This action is **FINAL**.                      2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

#### Disposition of Claims

- 4) ☒ Claim(s) 1-20 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-20 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_ are subject to restriction and/or election requirement.

#### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

#### Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All    b) ☐ Some \* c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

#### Attachment(s)

- |  |   |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)  | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. ____. |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)                                   | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152)             |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)<br>Paper No(s)/Mail Date ____. | 6) <input type="checkbox"/> Other: ____.  |

## DETAILED ACTION

### *Claim Rejections - 35 USC § 102*

1. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

2. Claims 1-4 are rejected under 35 U.S.C. 102(b) as being anticipated by Kotani et al., U.S. Patent Number 5,766,751.

Kotani discloses a laminate film comprising a layer comprising a substance having a gas barrier property and at least one layer which is disposed on the gas barrier substance layer and comprises a resin composition comprising a resin and an inorganic laminar (layered) compound (see column 3, lines 9-15). Additionally, the reference discloses that the base material (e.g. resin film) can be a resin such as a polyolefin-type resin such as polyethylene, ethylene-propylene copolymer or polyester-type resin. Column 13, lines 40-68 of the reference disclose that a metal or oxide can be used as a substance having a gas barrier property and that the process for forming the film of the metal or oxide can be by the sol-gel method. It is disclosed in column 19, lines 19-24 that the oxygen permeability measurement at 30 deg C, 60% RH was below 0.1 cc/m<sup>2</sup> day atm for the laminate.

3. Claims 1-20 are rejected under 35 U.S.C. 102(e) as being anticipated by anticipated by Iwanaga, U.S. Pre Grant Publication 2004/0209090.

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The applied reference has a common inventor with the instant application. Based upon the earlier effective U.S. filing date of the reference, it constitutes prior art under 35 U.S.C. 102(e). This rejection under 35 U.S.C. 102(e) might be overcome either by a showing under 37 CFR 1.132 that any invention disclosed but not claimed in the reference was derived from the inventor of this application and is thus not the invention "by another," or by an appropriate showing under 37 CFR 1.131.

Iwanaga discloses a gas barrier laminate film comprising a polymer base film having a material that has a glass transition temperature of 100 deg C or higher and that the film material can include polycarbonate or polyethylene naphthalate (see paragraph 0031). It is disclosed in paragraph 0019 of the reference that the polymer base film can have an inorganic layered compound. Paragraph 0011 of the reference discloses that the gas barrier layer can be obtained with the sol-gel method. Paragraph 0044 discloses that the gas barrier layer is a coating layer formed by the sol-gel method with an alkoxysilane hydrolyzed in a mixture containing at least one kind of alkoxysilane, acid catalyst and a hydrophilic resin. The reference discloses in paragraph 0082 that the hydrophilic resin may consist of a polyvinyl alcohol, which has a hydrogen bond-forming group such as hydroxyl group and derivatives thereof. Additionally, the reference discloses in paragraph 0107 that a monomer may be used together in the sol-gel reaction to produce an organic-inorganic hybrid material for the gas barrier layer. Iwanaga discloses that in order to make the film further dense after the coating and drying, irradiation of microwaves can be used. Paragraph 0122 of the Iwanaga reference discloses that the thickness of the polymer base film is preferably 5 to 500  $\mu\text{m}$ . Paragraph 0123 of the reference discloses that the thickness of the gas barrier layer is preferably 100 to 1000 nm. Paragraphs 0022-0025 of

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the reference disclose that the gas barrier laminate film can be used as a substrate or in an image display device, liquid crystal display device or an organic electroluminescent device.

### ***Double Patenting***

4. The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the “right to exclude” granted by a patent and to prevent possible harassment by multiple assignees. A nonstatutory obviousness-type double patenting rejection is appropriate where the conflicting claims are not identical, but at least one examined application claim is not patentably distinct from the reference claim(s) because the examined application claim is either anticipated by, or would have been obvious over, the reference claim(s). See, e.g., *In re Berg*, 140 F.3d 1428, 46 USPQ2d 1226 (Fed. Cir. 1998); *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) or 1.321(d) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent either is shown to be commonly owned with this application, or claims an invention made as a result of activities undertaken within the scope of a joint research agreement.

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Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

5. Claims 1-20 are provisionally rejected on the ground of nonstatutory obviousness-type double patenting as being unpatentable over claims 1-20 of copending Application No. 10/759,139. Although the conflicting claims are not identical, they are not patentably distinct from each other because both applications recite a gas barrier laminate film comprising a base material film and at least one gas barrier layer obtained by a sol-gel method. The claims of the co-pending application do not recite the difference between oxygen transmission rate at 25 deg in a relative humidity of 10% and an oxygen transmission rate at 25 deg C in a relative humidity of 90%. Both application recite a gas barrier laminate film comprising a polymer base film comprising an inorganic layered compound with a thickness of 5 to 500  $\mu\text{m}$  and a gas barrier layer comprising a polysilicate with a thickness of 100 to 1000 nm. Both applications recite the same product. Therefore, it would have been obvious to one of ordinary skill in the art to recognize that the difference between oxygen transmission rate at 25 deg in a relative humidity of 10% and an oxygen transmission rate at 25 deg C in a relative humidity of 90% for the gas barrier laminate in the co-pending application would be 0 to  $1.0 \times 10^{-5}$  ml/m<sup>2</sup> day Pa.

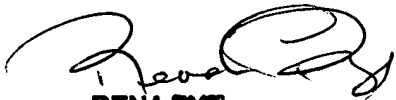
This is a provisional obviousness-type double patenting rejection because the conflicting claims have not in fact been patented.

Any inquiry concerning this communication or earlier communication from the examiner should be directed to Camie S. Thompson whose telephone number is (571) 272-1530. The examiner can normally be reached on Monday through Friday from 7:30 am to 4:00 pm. If

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attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Rena L Dye, can be reached at (571) 272-3186. The fax phone number for the Group is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

  
**RENA DYE**  
**SUPERVISORY PATENT EXAMINER**  
A.U. 1774 5/10/04